



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,111	06/24/1999	YASUMASA ONO	35.13605	8674

5514 7590 10/06/2003

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
----------	--------------

2645

14

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/344,111

Applicant(s)

ONO, YASUMASA

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Amendment B, 6/18/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 11 recite the limitation "the image signal" in lines 8 and 10 respectively.

There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2,4-5,11-12,14-15 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Mizikovsky** (US 5,559,860).

As to Claim 1, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a communication apparatus capable of receiving communication information from the outside, comprising:

discrimination means, 44 and 46, for discriminating presence or absence of reception of the communication information (Figure 1 and Figure 5, labels 502,504); and

control means, 44 and 46, for executing control, in case of reception of the communication information, to set a peripheral device (recording apparatus), capable of

Art Unit: 2645

recording the communication information, in a state capable of recording (Figure 5, labels 520,522);

wherein said control means executes control, in a case where the communication information is judged as a (the) image signal, to cause the recording apparatus to start recording and to start recording and to record the recording start point at the start of recording (Col. 7, lines 51-67); and

wherein said communication apparatus and said peripheral device (recording apparatus) are connected to each other through peripheral multi-purpose interface (a network), and said control means executes a communication protocol of said network and transmits a command to start the recording for said recording apparatus (Col. 7, lines 21-27).

As to Claims 2,12, **Mizikovsky** teaches a communication apparatus according to claim 1, wherein said discrimination means has a function of:

discriminating whether the communication information is an image signal, and said control means executes control, in case the communication information is judged as the image signal, to cause the recording apparatus to start recording (Figure 5).

As to Claims 5,15, **Mizikovsky** teaches a communication apparatus according to claim 1, wherein said recording apparatus includes transmission means for transmitting said communication information, and said control means executes control, through said transmission means, to set the recording apparatus in a state capable of recording (Figure 5).

Art Unit: 2645

As to Claim 11, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a communication information recording method adapted for use in a communication apparatus capable of receiving communication information from the outside, the method comprising:

a discrimination step of discriminating presence or absence of reception of the communication information (Figure 1 and Figure 5, labels 502,504); and

a control step, of executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 5, labels 520,522);

wherein said control step includes executing control, in a case where the communication information is judged as the image signal, to cause the recording apparatus to start recording and to record the the recording start point at the start of recording (Col. 7, lines 51-67); and

wherein said communication apparatus and said recording apparatus are connected to each other through a network, and said control step executes control using a communication protocol of said network and transmits a command to start recording for said apparatus (Col. 7, lines 7-21).

As to Claim 21, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a computer readable memory medium storing a program for executing a communication information recording method adapted for use in a communication apparatus capable of receiving communication information from the outside, the method comprising

a discrimination step of discriminating presence or absence of reception of the communication information (Figure 1 and Figure 5, labels 502,504); and

Art Unit: 2645

a control step of executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 5, labels 520,522);

wherein said control step includes executing control, in a case where the communication information is judged as the image signal, to cause the recording apparatus to start recording and to record the recording start point at the start of recording (Col. 7, lines 51-67);

wherein said communication apparatus and said recording apparatus are connected to each other through a network, and said control step executes control using a communication protocol of said network and transmits a command to start recording for said apparatus (Col. 7, lines 7-21).

As to Claims 4,14, **Mizikovsky** teaches a communication apparatus according to claim 3, wherein said control means executes control, in case the communication information is judged as the image signal, to cause said recording apparatus to start recording and to record identification information for recognizing the recording start point at the start of recording (Col. 7, lines 21-30 and 51-67).

5. Claims 6-10 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Gerszberg et al.** (US 6,052,439).

As to Claims 6,16, **Mizikovsky** teaches a communication apparatus according to claim 5:

**Mizikovsky** does not teach the following limitation:

“wherein said transmission means transmits said communication information

according to the IEEE 1394 based interface standard”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches the use of protocols for activating different peripheral devices. **Gerszberg** teaches the limitation (Col. 5, lines 1-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add IEEE 1394 capability to **Mizikovsky**’s invention for providing networking as taught by **Gerszberg**’s invention in order to provide desirable network interfaces.

As to claims 7,17, **Mizikovsky** teaches a communication apparatus according to claim 6, wherein said communication apparatus is applicable to a message telephone (Figure 1, label 50).

As to claims 8-9,18-19, **Mizikovsky** teaches a communication apparatus according to claim 1.

**Mizikovsky** does not teach the following limitation:

“wherein said recording apparatus is a magnetic recording apparatus”

**Gerszberg** teaches the limitation (Col. 8, lines 7-17). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add magnetic storage capability to **Mizikovsky**’s invention for providing storage as taught by **Gerszberg**’s invention in order to provide appropriate storage of information.

As to Claims 10,20, **Mizikovsky** teaches a communication apparatus according to claim 8, wherein said recording apparatus is a hard disk device (Figure 1, label 52e).

Art Unit: 2645

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-2,4-12,14-21 have been considered but are moot in view of the new ground(s) of rejection.

Also, Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Michel et al.** (US 5,764,512) teach a PC-system which processes wideband and narrowband information.

**Dunlap** (US 5,189,691) teaches a video answering machine with answering machine controls.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Application/Control Number: 09/344,111

Page 8

Art Unit: 2645

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Allan Hoosain*  
Allan Hoosain  
Primary Examiner  
9/29/03